

REMARKS

Claims 1-48 were pending in the subject application. By this Amendment, applicants have amended claims 1-7, 11-13, 15, 16, 20-22 and 43 and cancelled claims 37-42 and 48, without prejudice or disclaimer to pursue the subject matter of previous claims 37-42 and 48 in a future continuation or divisional application. Applicants have amended claims 1-7, 11-13, 15, 16 and 20-22 by increasing the font size of the variables within the embedded structures and/or amending the dependencies of claims. Applicants have amended claim 43 to remove urge incontinence from the list of indications. Accordingly, upon entry of this Amendment, claims 1-36 and 43-47 will be pending and under examination.

I. CLAIM OBJECTIONS

The Examiner objected to claims 3-7, 11-13, 15, 16 and 20-22 under 37 C.F.R. 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternate only.

In response, applicants have amended each of claims 3-7, 11-13, 15, 16 and 20-22 to be now dependent on a single claim. Claim 3 is now dependent on claim 2. Claim 4 is now dependent on claim 3. Claim 5 is now dependent on claim 4. Claim 6 is now dependent on claim 5. Claim 7 is now dependent on claim 6. Claim 11 is now dependent on claim 2. Claim 12 is now dependent on claim 11. Claim 13 is now dependent on claim 12. Claim 15 is now dependent on claim 2. Claim 16 is now dependent on claim 15. Claim 20 is now dependent on claim 19. Claim 21 is now dependent on claim 20. Claim 22 is now dependent on claim 21.

Accordingly, applicants respectively request that the Examiner reconsider and withdraw this ground of objection.

II. 35 U.S.C. 112, First Paragraph

The Examiner rejected claims 37-48 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The Examiner asserted that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. The Examiner stated that the instant specification teaches compounds as MCH1 receptor ligands as evidenced by binding data on Table I and further stated that the specification provides guidance to test the effects of the instant compounds in animal models of obesity,

depression, anxiety and urge incontinence. The Examiner asserted that there are no working examples and that there is no teaching either in the specification or prior art regarding specific disorders which are solely mediated by MCH1 receptors.

In response, applicants have cancelled claims 37-42 and 48 without prejudice or disclaimer to pursue the subject matter of previous claims 37-42 and 48 in a future continuation or divisional application and have amended previous claim 43 to remove urge incontinence. Applicants respectively traverse this rejection as it applies to new claims 43-47 and respectively maintain that the specification enables the skilled artisan to make and use the invention of new claims 43-47, namely methods of treating depression, anxiety and obesity comprising administering a therapeutically effective amount of the compound of the invention.

First, applicants note that MPEP 2164.02 states "Compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, does not turn on whether an example is disclosed. An example may be "working" or "prophetic". A working example is based on work actually performed. A prophetic example describes an embodiment of the invention based on predicted results rather than work actually conducted or results actually achieved." Secondly, MPEP 2164.02 further states "An in vitro or in vivo animal model example in the specification, in effect, constitutes a "working example" if that example "correlates" with a disclosed or claimed method invention."

As stated in MPEP 2164.02, applicants note that a working example is not required for the enablement requirement to be satisfied since "An in vitro or in vivo animal model example in the specification, in effect, constitutes a "working example" that "correlates" with a disclosed or claimed method invention." Applicants further note that the animal models disclosed in the specification are "prophetic" examples that constitute "working" examples and that these "working" examples correlate with the method invention of claims 43-47. Specifically, applicants note that the animal models disclosed on page 113, line 1 through page 120, line 37 are well established in the art as correlating to subject matter of claims 43-47.

In response to the Examiner's assertion that there are no working examples or teaching in the prior art regarding specific disorders which are solely mediated by MCH1 receptors, applicants respectively disagree. To support applicants' arguments, enclosed herewith as Exhibit A is PCT

International Publication No. WO 02/02744, published January 10, 2002. Applicants note that WO 02/02744 discloses MCH1 ligands and their effects in animal models of depression, anxiety and obesity on page 402, line 1 through page 415, line 19. Applicants note that the subject application has a priority date of July 3, 2002 and that WO 02/02744 on published January 10, 2002. Specifically, WO 02/02744 teaches that the MCH1 antagonist of compound 10 was shown to be active in these animal models and that these models correlate to treatment of human conditions.

Accordingly, applicants respectively maintain that a prima facie case of non-enablement has not been established and request that the Examiner reconsider and withdraw this ground of rejection.

III. 35 U.S.C. 112, Second Paragraph

a. The Examiner rejected claims 1-5, 21 and 22 under 35 U.S.C. 112, second paragraph, being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. The Examiner asserted that the variables t and n are not legible in the structural formula of independent claim 1 and that the variable n is not legible in the structural formula of claims 2-5, 21 and 22.

In response, and in an attempt to advance the prosecution of the subject application but without conceding the correctness of the Examiner's position, applicants have amended claims 1-5, 21 and 22 by increasing the font size of the variables t and n to more clearly identify the variables. By increasing the size of the font, applicants maintain that the variables are now legible and respectively request the Examiner to reconsider and withdraw this ground of rejection.

b. The Examiner further rejected claims 34-48 (applicants believe the Examiner meant to state the rejection of claims 37 and 38 instead of claims 34-48 since he only mentions claims 37 and 38 in the body of the rejection) under 35 U.S.C. 112, second paragraph, being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. The Examiner further alleged that the term "disorder mediated by MCH1 receptor" in claims 37 and 38 is indefinite since the specific disorders are not defined.

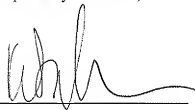
In response, applicants have cancelled claims 37 and 38, without prejudice or disclaimer to pursue the subject matter of previous claims 37 and 38 in a future continuation or divisional application, thereby rendering this ground of rejection moot.

CONCLUSION

In light of the remarks made hereinabove, applicants believe that the application is now in condition for allowance. Such action is earnestly solicited. If a telephone conference would be of assistance in advancing the prosecution of the subject application, applicants' undersigned agent invites the Examiner to telephone him at the number provided below.

No fee, besides the three-month extension of time fee of \$1020.00 is required. Authorization is hereby given to charge this amount to Deposit Account No. 503201. No other fee is deemed necessary in connection with the filing of this Amendment. Any deficiency or overpayments should be charged or credited to Deposit Account No. 503201.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Kitae Lim', written over a horizontal line.

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